

**REMARKS****I. Introduction**

In response to the pending Office Action, Applicants have amended the Abstract so that it is in compliance with the requirement of the 150 word limit. In addition, the specification has been amended so as to provide an express reference to reference numerals 1a, 1b, 2a, 2b, 3a and 3b contained in the figures. Support for this amendment can be found, for example, in the last paragraph of page 15. No new matter has been added.

It is further noted that as claims 1-4 are believed to be patentable over the cited art, if the Examiner agrees with the Applicants in this regard, it is respectfully requested that claims 5-8 be rejoined as these claims are ultimately dependent on claim 1. It is clear that claim 1 is generic to claims 5-8.

Applicants respectfully traverse the rejection of the pending claims in view of the prior art for the reasons set forth below.

**II. The Rejection Of The Claims Under 35 U.S.C. § 103**

Claims 1-4 were rejected under 35 U.S.C. § 103 as being unpatentable over USP Publication No. 2002/0012827 to Mizuno in view of Japanese Patent Publication No. 2000-133289 (the '289 patent). For the following reasons, Applicants respectfully submit that the pending claims are patentable over Mizuno and the '289 patent, taken alone or in combination with one another.

First, with regard to the present invention, claim 1 recites in pertinent part, "a fuel gas inlet-side manifold aperture ... an inlet-side through hole ... and an inlet-side connection groove ... for connecting said inlet-side [through hole] with said fuel gas inlet-side manifold aperture." Thus, in accordance with the present invention, a gas flow channel arranged on the anode side of

the separator to supply a fuel gas to the anode is provided with a through hole on the other side of the separator (i.e., cathode side) and that the through hole is coupled with a fuel gas manifold aperture via a connection groove to form a clearance between the gasket and the separator. The clearance communicates with the fuel gas manifold aperture so that the fuel gas and the oxidant gas are not mixed.

Turning to the cited prior art references, it appears in the pending rejection that Mizuno is interpreted as allegedly disclosing both “the fuel gas inlet-side manifold aperture” and the “inlet-side through hole.” However, Mizuno discloses only one set of manifold apertures for each gas line (i.e., oxidative and fuel) which lead directly into the respective gas passageways without first connecting to a through hole via a connection groove (i.e., oxidative gas 60-62 and fuel gas 63-65 flow directly into respective gas passageways 90-91). *Mizuno et al. does not disclose two separate holes, let alone two holes connected together by a connection groove.* Accordingly, for at least this reason, we believe the reliance on Mizuno as disclosing both an inlet-side manifold aperture and inlet-side through hole is in error.

Further, it is admitted that Mizuno does not disclose a connection groove (further evidencing that Mizuno does not disclose two holes in the manner recited in claim 1 as discussed above) and therefore relies on the gas inlet 11 of the ‘289 patent as a “connection groove.” However, adding the gas inlet 11 of the ‘289 patent into the device of Mizuno would not disclose the claimed invention. In particular, claim 1 recites in pertinent part, “a gas flow channel ... which is formed on an *anode*-side of the separator ...; and [the connection grooves] are formed on a *cathode*-side of the separator.” One exemplary embodiment of the present invention is shown in Figure 8 of Applicants’ drawings, where the connection groove 16a connects the through hole 15a to the manifold aperture 11a and is formed on the side of the separator 10

opposite to the gas flow channel 14. In contrast, the alleged connection groove 11 of the '289 patent is formed on the same side as the gas passages 10 (i.e., both passages 11 and 10 are formed on either the anode or cathode side of the separator).

Thus, even assuming *arguendo* that it is proper to combine Mizuno and the '289 patent, the combination thereof stills fails to disclose or suggest each and every limitation of the claimed invention. Accordingly, as each and every limitation must be disclosed or suggested by the cited prior art references in order to establish a *prima facie* case of obviousness (*see*, M.P.E.P. § 2143.03), and the combination of Mizuno and the '289 patent fails to do so for at least the foregoing reasons, it is respectfully submitted that the pending claims are patentable over the cited prior art.

Finally, it is also respectfully submitted that the proposed combination is improper because it lacks the necessary suggestion from the prior art. The pending rejection asserts as motivation for making the combination that the '289 patent "reveals that the specified side connection groove feature prevents a gas leak from a flat plate section covering a gas guide port and a discharge port." However, the '289 patent does not disclose that preventing a gas leak is attributable to forming the connection groove. Indeed, the '289 patent expressly discloses that the gas inlet 11 and plate 9 corresponding to the tunnel structure is subject to gas leaks (*see* Problem to Be Solved by the Invention section of the '289 patent). Rather, the '289 patent suggests using a coating film 12 to help block leaks *arising from the connection groove*. As such, the '289 patent does not provide any motivation for adding a connection groove and actually teaches away from such a construction in view of the leaks arising therefrom. The '289 patent suggests only using a coating film 12 for devices *having a* connection groove (as mentioned above, the device Mizuno does not have a connection groove) to help seal leaks.

Accordingly, it is respectfully submitted that the proposed combination is based solely on improper hindsight reasoning, whereby the Examiner selected bits and pieces of the prior art and used only Applicants' specification as a guide to reconstruct the claimed invention, which is clearly impermissible.

**III. All Dependent Claims Are Allowable Because The  
Independent Claim From Which They Depend Is Allowable**

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as independent claim 1 is patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also in condition for allowance.

**IV. Conclusion**

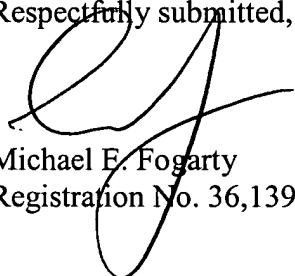
Accordingly, it is urged that the application is in condition for allowance, an indication of which is respectfully solicited.

If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

10/023,907

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,



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**Date: November 13, 2003**  
WDC99 831064-1.043888.0123